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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,810	02/25/2004	Jesus Benavides	ST01023 US CNT	3346

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EXAMINER

CHONG, YONG SOO

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



## **DETAILED ACTION**

### ***Status of the Application***

This Office Action is in response to applicant's arguments filed on 10/10/2006.

Claim(s) 3-9, 11-19, 22-28, 30-34 have been cancelled. Claim(s) 1-2, 10, 20-21, 29, 35-36 are pending. Claim(s) 10 has/have been amended. Claim(s) 1-2, 10, 20-21, 29, 35-36 are examined herein.

Applicant's arguments have been fully considered and found persuasive to withdraw the 103(a) rejection of the last Office Action. Therefore, finality of this case is hereby withdrawn. The following new rejections will now apply.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 20, 35-36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3-10, 15-28 of copending Application No. 10/786,483. Although the conflicting claims are not identical, they are not patentably distinct from each other because a combination of 1-

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[bis(4-chlorophenyl)methyl]-3-[(3,5-difluorophenyl)(methylsulfonyl)methylene]azetidine, which is a compound of formula I, and a product that activates dopaminergic neurotransmission is disclosed. The instant invention does not specifically disclose an example of 1-[bis(4-chlorophenyl)methyl]-3-[(3,5-difluorophenyl)(methylsulfonyl)methylene]azetidine and a product that activates dopaminergic neurotransmission, but one of ordinary skill in the art would have had a reasonable expectation of success in formulating said combination for activating dopaminergic neurotransmission.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 1-2, 10, 20-21, 29, 35-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "combination" is unclear as to whether the dopamine-activating product and compound of formula I is a homogeneous mixture or not. Examiner notes that replacing "combination" with "composition" in the claims will overcome this rejection:

Claim 1-2, 10, 20-21, 29, 35-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "one or more

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products which activate dopaminergic neurotransmission in the brain” is unclear as to whether the said product is a synthetic or natural compound, what the source of said product is, and whether dopamine is up or down regulated. Examiner notes that replacing “one or more products which activate dopaminergic neurotransmission in the brain” with “dopaminergic agonists” in the claims will overcome this rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong S. Chong whose telephone number is (571)-272-8513. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SREENI PADMANABHAN can be reached on (571)-272-0629. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

YSC

SHENGJUN WANG  
PRIMARY EXAMINER